

Independent claims will be hereinafter underlined, as a courtesy, to more clearly point them out to the Examiner

The Examiner has asserted several indefiniteness rejections and each will be addressed in turn of original presentation. Original claim 2 has been cancelled and incorporated into new claim 142. What is claimed is the whole sheet of printable media wherein the laminate facestock, at an edge, is removed. An example of such a construction may be found in FIG. 26 and on pages 16-17. The strategic removal of a strip laminate facestock has been noted to improve feeding of the sheets. It is clear that this removal results in a sheet having a portion of the liner sheet exposed and without the laminate facestock and therefore new claim 142 is clear and definite, as well as any claim dependent thereon.

Language utilized in original claim 5 which, for example, now may be found in new claim 145, was rejected as being unclear. In particular, the Examiner stated that it is unclear how the facestock cut lines define an edge of the strip of the liner sheet. As an example, Applicant respectfully point out FIG. 26. Here, exemplary die cut line 724 in the facestock, provides a view of an edge of the underlying liner strip, when viewed "head-on" and defines a lower edge of wide strip 486 available for more efficient feeding of the sheet into a printer or copier, for example.

Applicants respectfully point out that claim 9 is directed to a sheet of printable media having alternating/discontinuous liner sheet strips. An exemplary construction may be found discussed and illustrated on pages 4 and 10 and in FIG. 7, respectively.

Original claim 16 is cancelled; however, the terminology recited therein may be found in new claim 155. Applicants respectfully point out that the claim refers to the sheet wherein strips of liner sheet are not removed from the sheet. The strips are not removed and provide better flexibility to the sheet during the various handling and printing process that the sheet may be subject to. An exemplary construction of such a sheet may be found in FIG. 7.

Claims 25 and 26 are cancelled as well, yet the same language may be found, for example, in new claims 164 and 231, respectively. Again, Applicants respectfully point out that the claims refer to sheets which are comprised of alternating/discontinuous liner sheet strips, as discussed above.

Similar language found in cancelled claim 27 may be found in new claims 165 and 197, for example. Applicants respectfully point out to the Examiner that the claim is directed to sheets wherein “some of said liner sheets...are removed...”. Additionally, the recitation of “..extend only part way across...” is in clear reference to the lie of the liner strip sheets “..across said laminate facestock...” as recited and not to the cut line in the liner sheet. An exemplary construction of this type is provided by FIG. 19a.

The term “dry tag” is a term of art, its meaning well known to those of ordinary skill in the labeling and paper construction arts. Typically, dry tags or labels have no tack when individually handled, and compositions which provide dry separation interfaces are well known in the art (see Examiner’s cited reference *Cross* 4,863,772) and as such the term has been retained in pending claims.

Claim 55 has been cancelled and terms recited therein may now be found in claims 239 and 273. The claim refers to the various attributes of the sheet of printable media, such as the ability of the printed media to be separable from the liner strips and the facecut lines defining a removable waste border portion. This claim does not recite the removal of the liner sheet.

Finally, the phrase “wavy curving side edges” in cancelled claim 58 may be found in new claims 241 and 279, for example. Examples of what is meant by “wavy curving side edges” may be found on page 11 and in FIG. 17 and 19, which exemplify cuts into the liner sheet which provide liners having “wavy curving side edges”.

In light of the above amendments and arguments, the Examiner is respectfully requested to withdraw his 35 USC 112, second paragraph rejections.

Turning to the Examiner's 35 USC 103(a) rejections, the Examiner contends that the primary reference, (*Klein* 5,198,275, hereinafter *Klein*) in combination with *Cross* 4,863,772 (hereinafter *Cross*) renders particular claims unpatentable. A closer study of the references shows that *Klein* and *Cross*, alone and in combination, fail to provide an basis for one of ordinary skill to provide the sheets of printable media claimed herein.

Firstly, analysis of *Klein* reveals that this particular patent is directed to a construction which for improvements in severability are provided by a combination of particular cuts and micro-perforations along a same line (FIG. 1) and is quite unlike the sheets of printable media claimed in the instant application. Furthermore, *Klein* discloses a "card or label which comprises a laminate of paper or other material including an information-carrying sheet 85 and a backing sheet 90. The face and backing sheets 85 and 90 are secured together by a contact adhesive 95 as shown in FIG. 6 " (col. 3 lines 16-20). As stated by the Examiner, *Klein* fails to teach or suggest sheets comprised of a film layer.

Referring to FIG. 8 of *Klein*, an extended card stock sheet which may be formed as a continuous strip, sized and fan folded, shows an infeed edge. Examples of sheets constructed according to the teachings of the present invention have unique edges, for improved feeding into copier or printers, for example. Infeed edges, as utilized herein, are the edges which are not parallel to the direction in which a sheet or sheets are feed into a printer, for example. As recited in pending claim 142, "...a strip of the laminate facestock at an edge of said laminate facestock is removed to expose a strip of said liner sheet..". This edge may also be calendered for improved feeding. There is absolutely no disclosure regarding any particulars about the infeed edges of the construction disclosed in *Klein* or the removal of a strip of laminate facestock, which provides a "step" cross section of the infeed edge, as seen in FIG. 26 of the instant application, for example.

Additionally, *Klein* fails to disclose any particular arrangement of cut lines which provide printed media wherein the printed media directly abut one another and share common edges, as claimed in the instant application. Additionally, *Klein* fails to teach or suggest a construction wherein alternating liner strips are removed from the sheet before printing operations. As a

matter of fact, the *Klein* reference fails to disclose, teach or suggest any desirability regarding the cutting, removal, size, shape or locations of liner cuts for improvements in feeding and/or reduction of curling, flexibility or support of printable media through a printing or coping process, as appreciated by the Applicants.

Turning to *Cross*, we note that this patent is directed solely to a label construction with a dry separation interface, as is apparent from the title of the patent. There are no teachings or suggestions regarding the size, shapes, arrangement or removal before printing of liner strips or cuts made to the liner sheet disclosed therein. Furthermore, this patent does not contain any disclosure regarding the positional relationship of the liner cuts either to each other or to cuts made in facestock. As such, this reference, when taken in combination with the *Klein* patent, fails to remedy the numerous deficiencies previously discussed and brought out in the above arguments.

Applicants respectfully disagree with the Examiner's further contention that "...it would have been an obvious matter of design choice to alter the width of any of the strips in the liner, the thickness of the infeed edge, the widths of the liner sheet widths or distance of the leading edge cut line, since such a modification would have involved a *mere* change in the size of a component...[emphasis added]". The discovery by the Applicants of the disclosed placement and sizes of the various components, including cuts, of the sheets is not a mere change in size, but rather provides the disclosed sheets with improved functional characteristics, such as sturdiness, flexibility and reductions in memory curl induced by printing process, for example.

For example, the construction of *Klein* fails to disclose or even suggest a sheet having frame cut lines 244 and grid cut lines 248 which separate the central area into a plurality of rectangular printable cards, each card sharing a common edge with another, as exemplified in FIG. 8 in the present application. The cited references also fail to disclose or suggest an endcut line, for example line 256 in FIGs. 8 and 11.

The sheets claimed in the present application have unique , non-obvious and functionally useful configurations and combination of various components. Referring in particular to the

pending independent claims, each recites novel features and/or combination of features not found or taught in the cited references. As noted in independent claims 62, 142, 166, 230, 269 a unique feature of the claimed sheet is the configuration of a sheet having a liner sheet or backing sheet portion or strip which extends past an edge of overlying laminate facestock. This is one method by which an edge of the claimed sheets may be thinner along an entire width of the sheet to define an infeed edge, as recited in claim 211. Such an edge may be calendered along an infeed edge, as recited in claim 198, and provides an increase in the feeding reliability of the sheets. Such treatments are not suggested or taught in *Klein* or *Cross* and Applicants respectfully point out that 35 U.S.C. §103 requires an analysis of the claimed invention as a whole, i.e., an analysis of the claimed combination of elements. Even where the claimed invention is comprised of individual components well known at the time of invention, "[w]hat must be found obvious to defeat the patent is the claimed combination." The Gillette Co. v. S.C. Johnson & Son Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). It is impermissible to simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill in the gaps.

Pending independent claim 29 recites a flexibility cut line extending the full length of a first end liner strip and the flexibility cut line being disposed between a first edge and a first cut line and dividing a first end liner strip into two parts. Configurations of liner and facestock cuts such as these are not found in the primary or secondary references. Additional non-obvious and novel cuts, such as frame cut lines including a pair of side cut lines spaced in from respective side edges and parallel thereto and a pair of end cut lines spaced in from respective end edges, both of the end cut lines engaging both of the side cut lines and none of the side and end cut lines engaging any of the sheet edges, are recited in claim 33. The arrangement of cuts in claim 33 also provides frame cut lines separating the facesheet stock into a central area and a frame encircling the central area where the grid cut lines are defining a grid disposed in the central area and the grid cut lines and the frame cut lines separate the central area into a plurality of rectangular printable cards. This arrangement is not taught or suggested by the cited references. Independent claim 227, for example, recites that a feature of that sheet has a leading-edge cut

line which provides flexibility to the lead edge of the sheet for feeding the sheet into a printer or copier or transport therethrough. No such cut line is disclosed in the cited references.

In independent claim 223, an advantageous configuration of liner strips is disclosed which improves the flexibility and feeding of the sheets. For example, there is no disclosure or suggestion in the cited references wherein strips include strips of a first width and strips of a second width which is different than the first width, the strips of the first width being positioned between and parallel to the strips of the second width. FIG 21 is an exemplary depiction of sheets having liner configurations in accordance with the teachings of the present invention.

Furthermore, the printable media provided by the present invention, in some embodiments, directly abut one another and share common edges, as recited in claims 234, 245, 278, 279, 280 and 281, a feature not taught or suggested by *Klein* nor *Cross*.

For example, and as recited in claim 177, the sheets disclosed herein may have facestock cut lines also defining an inner perimeter of a waste border portion having cut lines which are continuous and run parallel to outside edges of the sheet of printable media, surrounding the printable media and sharing a plurality of at least in part edges of printable media. Referring to the border portion of the constructions disclosed by *Klein*, the rectangular score cut 100, defines marginal edge portions which enclose a single panel 105. These cuts are not continuous and are unlike the cuts presently disclosed, which may define a border waste portion as provided by the teachings of the present invention (exemplary cut 244 in FIG. 11).

Claim 232 is also allowable due, in part, to the novel and unobvious limitation of liner sheet strips which extend only part way across the laminate facestock and are removed from the laminate facestock before the sheet is fed into a printer or copier for a printing operation on a first side. A media sheet having liner strips removed or in alternating configuration, let alone strips having the exemplary configuration depicted in FIG. 19a, before printing operations are performed, for example, is not taught or suggested by the references cited. Therefore claims reciting such a limitation are allowable.

Likewise, Applicants further disagree with the contention that "...it would have been obvious...to remove alternating liner sheet strips from the laminate facestock because it would improve surface traction in a printer make the laminate more flexible". As stated previously, neither the *Klein* nor *Cross* disclose such teachings. As stated by the Federal Circuit In re Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697, that "deficiencies of the cited references cannot be remedied by ... general conclusions about what is 'basic knowledge' or 'common sense'." Applicants respectfully request the Examiner to point out and distinguish where and what renders such liner modifications obvious to one of ordinary skill at the time of the filing of this application. Applicants respectfully contend that claims reciting such a limitation are allowable.

The addition of the remaining cited references (*Carides et al.* and *Malhotra*) does not remedy the deficiencies of the primary and secondary references, as detailed above. Therefore, Applicants respectfully submit that rejections based upon any combination of cited patents has been traversed.

Therefore, in light of the above added claims, canceled claims and arguments, Applicants respectfully solicit acceptance and entry of this amendment and furthermore respectfully request that the Examiner withdraw all 35 USC 112/103 rejections of pending claims. Allowance of all pending claims is earnestly requested.

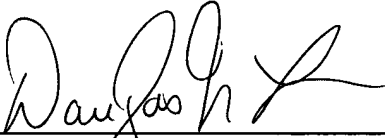
If there are any remaining issues, the Examiner is encouraged to telephone counsel to seek to resolve them.

Any additional fees required in connection with this communication which are not specifically provided for herewith are authorized to be charged to the Deposit Account No. **16-2230 in the name of Oppenheimer Wolff & Donnelly LLP. Any overpayments are also authorized to be credited to this account.**

Respectfully submitted,

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